

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

EMPEDOCLES *et. Al.*

Application No.: 10/674,071

Filed: September 30, 2003

**For: Applications of Nano-Enabled
Large Area Macroelectronic
Substrates Incorporating
Nanowires and Nanowire
Composites**

Confirmation No.: 1212

Art Unit: 2632

Examiner: To Be Assigned

Atty. Docket: 2132.0070002

Petition Under 37 C.F.R. § 1.78(a)(3)

Mail Stop Petition

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to amend the benefit claim of the above-captioned application. Accompanying this petition are the following:

1. The required reference to related applications, amended to indicate the relationship of this application to the prior provisional application, as set forth in a Second Preliminary Amendment; and
2. The petition fee under 37 C.F.R. § 1.17(t) is provided in our accompanying PTO-2038 Credit Card Payment Form.

The concurrently submitted Second Preliminary Amendment and Third Supplemental Application Data Sheet adds a benefit claim to U.S. Provisional Application No. 60/445,421 (the '421 Provisional), filed February 5, 2003, which was co-pending with the above-captioned Non-provisional Application No. 10/674,071 (filed September 30, 2003). The amendment does not change the earliest claimed benefit date.

A First claim to priority was filed with the application on September 30, 2003, claiming the benefit of U.S. Provisional Application Nos.: 60/414,323, filed September 30, 2002; 60/468,276, filed May 7, 2003; 60/474,065, filed May 29, 2003; and 60/493,005, filed August 7, 2003.

On May 27, 2004, Applicants filed a Preliminary Amendment and Second Supplemental Application Data Sheet *without* a Petition under Rule 78 to add a claim to priority to the '421 Provisional, because Applicants' representatives misinterpreted the 16 month period to run from the filing date of the '421 Provisional to which priority was sought.¹ The undersigned has just come to learn that the 16 month period runs for the earliest priority date claim in the application.² Thus, the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date this claim is being filed was unintentional.

1. "(4)A nonprovisional application ... may claim an invention disclosed in one or more prior-filed provisional applications. ... (5) (i) Any nonprovisional ... must contain or be amended to contain a reference.... (ii) This reference must be submitted during the pendency of the later-filed application. [and] ... must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date *of the prior-filed provisional application*." 37 C.F.R. § 1.78. The statute does not state the "earliest" prior-filed provisional application. Thus, a plain reading of the statute implies the 16 months runs from the date of the application to which priority is sought.

2. The rule was clarified for the undersigned during a recent telephone conference with Mr. John J. Gillon of the Office of Petitions.

The U.S. Patent and Trademark Office is hereby authorized to charge any additional fees, including the fee for Petition to Under 37 C.F.R. § 1.78(a)(3) if necessary, and any additional extensions of time that may be necessary to prevent abandonment of this application, to our Deposit Account No. 19-0036.

Respectfully submitted,

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Date: 4/26/05

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